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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/832,440

Filing Date: April 11, 2001

Appellant(s): MORSA, STEVE

Steve Morsa
Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/27/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct. However, the appellant has failed to provide a separate summary for each claim group indicated below.

Furthermore, the brief does not contain a concise explanation of the invention defined in the claims involved in the appeal, which refers to the specification by page

and line number, and to the drawing, if any, by reference characters as required by 37 CFR 1.192(c)(5).

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes statements that the claims should be grouped as follows:

- A) 1, 16-24, 26-27, 30, 46-52, 54-55, 58-62, 64-74, 83-87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, 148-158, 177-180. These claims do not stand or fall together.
- B) 80, 81, 82. These claims stand or fall together.
- C) 164-168. These claims do not stand or fall together.
- D) 169-175. These claims do not stand or fall together.
- E) 176. This claim stands or falls on its own.

However, Appellant's brief includes a statement that groupings A (claims 1, 16-24, 26-27, 30, 46-52, 54-55, 58-62, 64-74, 83-87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, 148-158, 177-180), C (claims 164-168) and D (169-175) do not stand or fall together; but, fails to provide reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). MPEP § 1206.

Furthermore, the appellant fails to disclose why each grouping (A-E) is patentably distinct, and further, fails to summarize each patentably distinct grouping in the summary section.

Finally, the appellant's statement in the brief that certain claims do not stand or fall together is not agreed with, because the appellant fails to show that each claim in groupings A, C, and D are patentably distinct; but, rather merely claims that each claim element is not disclosed by the cited references.

Thus, the rejection of claims 1, 16-24, 26-27, 30, 46-52, 54-55, 58-62, 64-74, 83-87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, 148-158, 177-180 (Group A); claims 164-168 (Group C); claims 169-175 (Group D) will stand or fall together, based on the broadest claim in the grouping.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

www.collegeboard.com Retrieved from Internet 1-1999

Wayback Machine.

6,266,648 BAKER, III 7-2001

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. **Claims 1, 80, 164, 169, and 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over College Board (www.collegeboard.com; additional material has been included in the appendix of the Examiner's Answer to further disclose the teachings of College Board; all available archived pages can be found at www.archive.com) in view of Baker, III (US 6,266,648).**
3. As per **independent Claim 1**, College Board discloses a system for permitting an entity to more effectively make use of a variety of available benefits (pg.2, scholarships, loans, internships, etc.) from a plurality of goods, services, information, and value benefit providers (pg.2, aid programs), wherein said benefits are offered specifically to those entities qualified/eligible to receive said benefits (profile form/ExPAN match qualified/eligible benefits, pg.2, pg.5), said system comprising: means for storing in a memory in the system entity

information, benefit-provider information, and benefit correlation information (inherent to website operating principles); means for inputting into said system a set of entity demographic, geographic, psychographic, and preference data for said entity (profile form, pgs.3-4); means for comparing (comparing is an inherent element in matching qualified/eligible benefits, pg.2, pg.5) said entity data set to determine those benefit-providers, if any, which have benefits said entity is qualified to utilize; means for analyzing said benefit-provider information and said benefit correlation information to determine whether any benefit-providers are offering potentially applicable benefits for said data and whether said data satisfies requirements for obtaining said potentially applicable benefits (matching qualified/eligible benefits, pg.2, pg.5); means for displaying a message to inform a system user of any available benefits applicable to said data (output of submitted form would be impossible to show from archived web page, but description of web-based system stated that a match would be provided to the user, pg.2, pg.5); wherein said benefits includes at least one of a discounted rate or value (scholarship, pg.2) available to the entity as a result of entity's qualifying (profile matching, pg.2, pg.5) or being eligible for at least one benefit available from at least one benefit provider. (www.collegeboard.com, pgs.1-13)

4. Although College Board does disclose the ability to provide benefits from scholarships, loans, and grants (3 different types of benefits, pg.2), College Board fails to expressly disclose means for inputting into said system benefit information from two or more distinctly different benefit classes/categories.

5. However, Baker (meant to serve as a teaching reference) discloses a method/system for permitting a consumer to more effectively make use of a variety of available benefits from a plurality of goods and service providers (abstract, C3 L5-51).
6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included means for inputting into said system benefit information from two or more distinctly different benefit classes/categories, as disclosed by Baker in the system disclosed by College Board, for the advantage of providing a benefits matching/correlation system, with the ability to increase system effectiveness/customer service by incorporating a variety of benefits from a plurality of goods and service providers.
7. College Board also fails to expressly disclose wherein said system is unlimited in the number of distinctly different benefit classes/categories it may offer said entity.
8. However, the term “unlimited” is impossible to incorporate into a automated system (omnibus language); and furthermore, as stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made provide a benefits matching/correlation system, with the ability to increase system effectiveness/customer service by incorporating a “large” variety of benefits from a plurality of goods and service providers.
9. As per **Independent Claim 80**, College Board discloses a system comprising: a memory device having embodied therein information relating to a plurality of

benefits (pg.2, scholarships, loans, internships, etc.); a processor in communication with said memory device (inherent to website operating principles), said processor configured to: create a benefits listing for a specified entity with a specified set of demographic, geographic, psychographic, and preference data (profile form, pgs.3-4); make available said benefits listing; examine a plurality of benefits that are available to a plurality of entities (output of submitted form would be impossible to show from archived web page, but description of web-based system stated that a match would be provided to the user, pg.2, pg.5), said listing to determine which of said plurality of benefits having qualification parameters (matching profile, pg.2); select at least one of said plurality benefits (pgs.5-9); and provide notification of benefit information to said entity, including the benefit providers corresponding to said selected benefits (pgs.5-9). (www.collegeboard.com, pgs.1-13).

10. Although College Board does disclose the ability to provide benefits from scholarships, loans, and grants (3 different types of benefits), College Board fails to expressly disclose wherein the benefits are from at least two distinctly different benefit classes/categories.
11. However, Baker (meant to serve as a teaching reference) discloses a method/system for permitting a consumer to more effectively make use of a variety of available benefits from a plurality of goods and service providers (abstract, C3 L5-51).

12. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the benefits are from at least two distinctly different benefit classes/categories, as disclosed by Baker in the system disclosed by College Board, for the advantage of providing a benefits matching/correlation system, with the ability to increase system effectiveness/customer service by incorporating a variety of benefits from a plurality of goods and service providers.

13. As per **Independent Claim 164**, College Board discloses a method comprising the steps of: receiving a request for benefit information (pg.2); querying (matching profile data with database information), using a computer, a central benefit information storage system (inherent to website operating principles) containing at least two distinctly different benefit types (pg.2, scholarships, loans, internships, etc.), to determine if any benefits exist for benefit information requester; receiving, using a computer, said benefit information (output of submitted form would be impossible to show from archived web page, but description of web-based system stated that a match would be provided to the user, pg.2, pg.5); accepting at least one of said available benefits (selecting scholarship, pg.5). (www.collegeboard.com).

14. Although College Board does disclose the ability to provide benefits from scholarships, loans, and grants (3 different types of benefits), College Board fails to expressly disclose wherein the benefits contain at least two distinctly different benefit classes/categories.

15. However, Baker (meant to serve as a teaching reference) discloses a method/system for permitting a consumer to more effectively make use of a variety of available benefits from a plurality of goods and service providers (abstract, C3 L5-51).
16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the benefits contain at least two distinctly different benefit classes/categories, as disclosed by Baker in the system disclosed by College Board, for the advantage of providing a benefits matching/correlation system, with the ability to increase system effectiveness/customer service by incorporating a variety of benefits from a plurality of goods and service providers.
17. As per **Independent Claim 169**, College Board discloses a method of using a computer to process a benefit information request (pg.2), comprising the steps of: creating a benefit listing (pg.2, scholarships, loans, internships, etc.); outputting said benefit listing via electronic system (inherent to website operating principles); examining (matching) a plurality of benefits which would fulfill the benefit information request relating to said benefit listing to determine which if any, of said plurality of benefits to select for said benefit listing; selecting, when available, at least one of said plurality of benefits; outputting notification of benefit information corresponding to said selected benefits (output of submitted form would be impossible to show from archived web page, but description of web-based system stated that a match would be provided to the user, pg.2, pg.5) and

accepting at least one of said benefits (selecting scholarship, pg.5).
(www.collegeboard.com, pgs. 1-13)

18. Although College Board does disclose the ability to provide benefits from scholarships, loans, and grants (3 different types of benefits), College Board fails to expressly disclose wherein the benefits contain at least two distinctly different benefit classes/categories.

19. However, Baker (meant to serve as a teaching reference) discloses a method/system for permitting a consumer to more effectively make use of a variety of available benefits from a plurality of goods and service providers (abstract, C3 L5-51).

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the benefits contain at least two distinctly different benefit classes/categories, as disclosed by Baker in the system disclosed by College Board, for the advantage of providing a benefits matching/correlation system, with the ability to increase system effectiveness/customer service by incorporating a variety of benefits from a plurality of goods and service providers.

21. As per **Independent Claim 176**, College Board discloses a method comprising the steps of: viewing, using a computer, benefit information (College Board website, pgs.1-2); transmitting, using a computer, a request to obtain at least one benefit corresponding to said benefit information (submitting profile, pg.2, pg.5); receiving a commitment for at least one benefit (output of submitted form would

be impossible to show from archived web page, but description of web-based system stated that a match would be provided to the user, pg.2, pg.5); accepting said commitment for said at least one benefit (selecting scholarship, pg.5); and receiving said at least one benefit (pgs.5-9). (www.collegeboard.com, pgs.1-13)

22. Although College Board does disclose the ability to provide benefits from scholarships, loans, and grants (3 different types of benefits), College Board fails to expressly disclose wherein the benefits are from at least two distinctly different benefit classes/categories.

23. However, Baker (meant to serve as a teaching reference) discloses a method/system for permitting a consumer to more effectively make use of a variety of available benefits from a plurality of goods and service providers (abstract, C3 L5-51).

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the benefits are from at least two distinctly different benefit classes/categories, as disclosed by Baker in the system disclosed by College Board, for the advantage of providing a benefits matching/correlation system, with the ability to increase system effectiveness/customer service by incorporating a variety of benefits from a plurality of goods and service providers.

(11) Response to Argument

1. The appellant makes the argument that the prior art of College Board fails to disclose a benefits matching system with unlimited classes/categories or types of benefits available for matching.
2. As Stated in the rejections above, College Board does disclose the ability to provide benefits from scholarships, loans, and grants (3 different types of benefits, pg.2).
3. However, College Board fails to expressly disclose means for inputting into said system benefit information from unlimited benefit classes/categories.
4. Baker (meant to serve as a teaching reference) discloses a method/system for permitting a consumer to more effectively make use of a variety of available benefits from a plurality of goods and service providers (abstract, C3 L5-51).
5. Furthermore, the term "unlimited" is impossible to incorporate into an automated system (omnibus language).
6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included means for inputting into said system benefit information from two or more distinctly different benefit classes/categories, as disclosed by Baker in the system disclosed by College Board, for the advantage of providing a benefits matching/correlation system, with the ability to increase system effectiveness/customer service by incorporating a "large" variety of benefits from a plurality of goods and service providers.

7. The Appellant has made the argument that the prior art of Baker fails to disclose specific features in the appellant's invention.
8. However, the Baker reference is intended to serve as a teaching reference, to show that at the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate a multitude of benefit types/classes into a matching system.
9. Furthermore, the appellant makes numerous arguments regarding the combination of the College Board and Baker references.
10. In response to applicant's numerous arguments that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both the College Board reference and the Baker reference deal with matching available benefits to qualified people in need. The College Board reference clearly discloses a benefit matching system for qualified users, and further discloses the matching of several types of benefits (pg.2, scholarships, loans, internships, etc.).

11. However, throughout application prosecution, the appellant has made the argument that College Board fails to disclose providing different (unlimited) benefits types/classes to users, and that the idea of providing different (unlimited) benefits types/classes to users is a novel concept.
12. Therefore, Baker is intended to be a teaching reference, showing it was well known at the time the invention was made to match users with different benefit types than those disclosed by College board; therefore, indicating it would be obvious to incorporate a multitude of benefit types/classes into the system disclosed by College Board.
13. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "all entities of all types") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
14. The Appellant has made several arguments (unexpected results, synergism, multiplicity of steps, objective evidence, commercial success, solution of long-felt need, and competitive recognition) indicating that the independent claims are unobvious and patentable over the cited references.
15. However, as stated in Chapter 700 of the MPEP:

**I. >< TO BE OF PROBATIVE VALUE, ANY OBJECTIVE EVIDENCE
SHOULD BE SUPPORTED BY ACTUAL PROOF**

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("It is well settled that unexpected results must be established by factual evidence." "[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant's heat shrinkable articles with those of the closest prior art, we conclude that appellant's assertions of unexpected results constitute mere argument."). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991).

**II. >< ATTORNEY ARGUMENTS CANNOT TAKE THE PLACE OF
EVIDENCE**

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant.

See MPEP § 2145 generally for case law pertinent to the consideration of applicant's rebuttal arguments.

I. >< BURDEN ON APPLICANT TO ESTABLISH RESULTS ARE UNEXPECTED AND SIGNIFICANT

The evidence relied *>upon< should establish “that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance.” *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in appellants’ brief that the claimed polymer had an unexpectedly increased impact strength “are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration.”); *Ex parte C*, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992) (Applicant alleged unexpected results with regard to the claimed soybean plant, however there was no basis for judging the practical significance of data with regard to maturity date, flowering date, flower color, or height of the plant.). See also *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) and *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) as discussed in MPEP § 716.02(c).

716.03(a) [R-2] Commercial Success Commensurate in Scope With Claimed Invention

**I. >< EVIDENCE OF COMMERCIAL SUCCESS MUST BE
COMMENSURATE IN SCOPE WITH THE CLAIMS**

Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam “cups” used in vending machines was not commensurate in scope with claims directed to thermoplastic foam “containers” broadly). In order to be commensurate *>in< scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff ’d*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.).

An affidavit or declaration attributing commercial success to a product or process “constructed according to the disclosure and claims of [the] patent application” or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. *Ex parte Standish*, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

16. The Appellant has also made several arguments (assumed insolubility, new principle of operation, references teach away, different problem solved, lack of implementation) indicating that the independent claims are unobvious and patentable over the cited references.

17. However, the above rejection discloses cited prior art which teaches the claimed invention (independent claims 1, 80, 164, 169, and 176), and was implemented through a website

18. Finally, the appellant makes the argument that the disclosed prior art fails to teach the feature in the dependent claims.

19. However, the groupings (A-E) will stand and fall together based on the broadest claims in the grouping (independent claims 1, 80, 164, 169, and 176). Therefore, the arguments regarding the dependent claims are moot.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



JO
October 26, 2004

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